UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

AT&T WIRELESS SERVICES, INC., Plaintiff, v. MORGAN & FINNEGAN, L.L.P., Defendant.	Case No. C03-0161L ORDER GRANTING IN PART DEFENDANT'S MOTION IN LIMINE REGARDING MICAH STOLOWITZ

This matter comes before the Court on "Defendant's Motion in Limine to Exclude Certain Testimony by Micah Stolowitz." Defendant argues that Mr. Stolowitz, a patent attorney, should not be permitted to offer his opinions regarding the patentability of AWS 562 (Opinion #1 of Expert Report), claim construction, whether the Patent and Trademark Office would have issued a patent had the application been timely filed (Opinion #4 of Expert Report[1]), and whether a statutory bar date existed (Opinion # 2 of Expert Report). Having reviewed the memoranda, declarations, and exhibits submitted by the parties, the Court finds as follows:

(1) The issues raised in defendant's motion can be resolved on the papers submitted by the parties. Defendant's request for oral argument is therefore DENIED.

[1] In the "Summary Statement of Opinions," Mr. Stolowitz' opinion regarding whether the PTO would have issued a patent is listed as #5, but it is discussed more fully under the heading "4. A Patent Would Have Issued from the AWS Application."

(2) As a patent attorney with almost twenty years of experience, Mr. Stolowitz has specialized knowledge regarding the standards and procedures the Patent and Trademark Office ("PTO") uses to evaluate a patent application and has, in the course of his employment, developed an expertise in advising clients regarding all aspects of intellectual property protection, including the patentability of a particular invention. For purposes of Opinion # 1, the Court does not find his lack of ordinary skill in the art to be determinative: patent attorneys regularly provide opinions regarding patentability, many of which require an investigation and analysis of prior art. Mr. Stolowitz' testimony regarding patentable subject matter, the novelty requirement, the nonobvious requirement, and whether AWS 562 satisfies those requirements in light of prior art[2] will assist the trier of fact in understanding the evidence and determining proximate cause.

(3) Mr. Stolowitz will not, however, be permitted to testify regarding what one of ordinary skill in the art would understand from the claim terms that would have issued had the AWS 562 application been timely filed. Mr. Stolowitz is not skilled in the art, as he acknowledged during his deposition (pages 90-91), and his testimony would not assist the Court in determining what one of ordinary skill in the art would have understood at the time the patent issued. If there is a dispute regarding how a particular claim should be construed, the restrictions imposed by Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582-83 (Fed. Cir. 1996), on the sequence and sources of information that can be consulted will apply. To the extent Mr. Stolowitz is permitted to offer any opinions regarding claim construction, the testimony will be limited to the type of interpretive rules discussed at pages 17-19 of the Expert Report.

---

[2] As an expert, Mr. Stolowitz is permitted to rely on hearsay information received from third parties, such as the prior-art search firm used to investigate the novelty and obviousness of AWS 562, as long as such information is "of a type reasonably relied upon by experts in the particular field in forming opinions or inferences upon the subject . . . ." Fed. R. Ev. 703.

The effect of this ruling is not clear. At this point in the litigation, with trial less than a week away, the Court assumes that there is no actual dispute regarding claim construction and that the main issues of patentability and infringement will be determined by the jury. Although defendants have mentioned the possible need for claim construction throughout this litigation, neither party has identified an actual dispute or requested that the Court construe the claims. Nor have the parties proposed a method by which claim construction could occur in the middle of a jury trial. The Court notes, without deciding, that it may well be too late to assert an inability to understand the terms of the AWS 562 application at this point.

(4) Although Mr. Stolowitz will be permitted to testify regarding how the PTO evaluates and processes patent applications, the standards of patentability, and whether the AWS 562 application satisfied those standards, he will not be permitted to testify that, in his opinion, the PTO would have issued a patent. Mr. Stolowitz will be permitted to testify to the extent of his expertise: the jury must thereafter decide whether a valid patent would have issued with substantially the same claims as presented in the application. That conclusion will be based on all of the evidence presented and does not require any particular expertise.

(5) The Court has already found that the invention was described in a printed publication on or before August 10, 2000. No testimony regarding the statutory bar date is necessary or will be admitted.

For all of the foregoing reasons, defendant's motion to exclude certain testimony of Micah Stolowitz is GRANTED in part and DENIED in part.

DATED this 25th day of April, 2005.

Robert S. Lasnik,
United States District Judge